

limitations that were added in order to avoid the cited prior art. In addition, it is well-known in the art that an evaporative mist is characterized by particles having a certain small size, which allows the small fluid particles to evaporative quite readily upon emission into the atmosphere.

The Rejection of Claims 5 and 7-10 under 35 U.S.C. §103(a) Should be Withdrawn.

The rejection of claims 5 and 7-10 under 103(a) over the combination of Cushing and Rosenberg, and additionally Shurnick et al. and Norman for claims 7 and 9, respectively, should be withdrawn because the combination is improper and none of the reference alone renders these claims obvious.

There is no motivation or suggestion to combine Rosenberg with Cushing in order to render claims 5 and 7-10 obvious. The mere fact that references can be modified is not sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (emphasis original). The subject of these two references differ from one another greatly and would not be considered together in the context of a hands-free water spraying device, or the present invention. Cushing is directed to a bicycle water pump that is used to deliver water to the rider without having to stop and dismount the bicycle. On the other hand, Rosenberg is directed to a surgical knife system that is able to suction away unwanted gas during surgery. Also, the clip in Rosenberg is used to anchor the end of the suction tube, see col. 6, lines 3-7, and is not used to attach the nozzle or delivery end used to spray water as is the clip of the present invention. One of ordinary skill in the art of water

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delivery would not have known to combine an element of the surgical knife system in Rosenberg to Cushing's water pump to yield a product that is similar to that claimed in the present application. Either reference alone fails to render the claimed invention obvious. With respect to Cushing, the Patent Office admits on page 3 of the Office Action that Cushing differs from the presently claimed invention in, at least, the alligator clip. With respect to Rosenberg, which teaches a surgical knife system that utilizes a suction mechanism, Rosenberg alone fails to teach anything closely resembling the presently claimed invention.

Additionally, the Patent Office also combined Shurnick et al. and Norman in order to develop a *prima facie* case of obviousness with respect to claims 7 and 9, respectively. With respect to claim 7, the Patent Office states on page 4 of the Office Action that Cushing/Rosenberg differs from the claimed invention in the means secured to the misting apparatus for attaching the misting apparatus to a person's waist, which Shurnick et al. is supposed to add. There is no motivation to combine Cushing with Shurnick et al. because none is actually provided in these references and there is no suggestion in the prior art of the desirability to combine a hands-free water delivery device of Cushing with a container for carrying water that allows for hands-free sipping of water, which is provided by Shurnick et al. With respect to claim 9, the Patent Office states on page 4 of the Office Action that Cushing/Rosenberg differs from the claimed invention in the manual piston pump, which Norman is supposed to add. The piston pump Norman discloses is used as part of a water sprayer/fire extinguisher apparatus, which is created to suction water for eventual expiration through a tube for spraying the material. The pump acts to pressurize the tank by sucking liquid into the tank of the apparatus, which compresses air already contained in the tank. This

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pressurizing means is significantly different from that in the claimed invention, which sucks in air to pressurized the tank, or container, that is already filled with water via the inlet in the tank. Therefore, one of ordinary skill would not have been motivated to combine Norman or Shurnick et al. with Cushing/Rosenberg.

Accordingly this rejection should be withdrawn.

The Rejection of Claims 11, 12 and 15-17 under 35 U.S.C. §103(a) Should be Withdrawn.

The rejection of claims 11, 12 and 15-17 under §103(a) over the combination of Cushing, Rosenberg, Shurnick et al. and Roueche should be withdrawn because all these references are needed to make out a *prima facie* case of obviousness and this combination is improper.

As discussed in the above section, the combination of Rosenberg and Shurnick et al. with Cushing is improper and cannot be part of *prima facie* case of obviousness. The combination of Rosenberg with Cushing is improper because there simply is no motivation to combine a surgical knife system that withdraws a gaseous fluid with an apparatus used to emit a liquid fluid. One of ordinary skill would not have known to combine the alligator clip in Rosenberg with the water pump disclosed in Cushing. The combination of Shurnick et al. with Cushing is also improper because there is no suggestion or motivation to combine an attachment element of a container for carrying water as described in Shurnick et al. with a hands-free water delivery device of Cushing. See the detailed discussions above. Accordingly, the combination of these references, all of which is required to form a *prima facie* case of obviousness, is improper and the references alone or in combination of less than all four cited references fail to render obvious the claimed invention; therefore this rejection should be withdrawn.

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The Obviousness Rejections Fail to Support a *Prima Facie* Case of Obviousness

Furthermore, with respect to all the various combinations of art presented by the Patent Office for the purpose of forming a *prima facie* case of obviousness, the combinations are improper because in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.' (Emphasis added, citations omitted).

No such actual evidence has been presented by the Patent Office and hindsight combination is not permissible. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."). Based on this erroneous combination, all §103 rejections are improper and should be withdrawn.

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Added Claims are Free From Prior Art

The applicant has added new claims (18-21) that provide inventions of varying scope than that presented in the current pending claims. The new set of claims is being added by new counsel for applicant, who began representing the applicant with respect to the above-identified application only after the receipt of the Office Action dated June 6, 2001.

Independent claim 18 is directed to an apparatus that is useful for evaporatively cooling an individual. The apparatus operates by delivering a continuous stream of fluid in the form of mist, particularly with water as the fluid, towards the individual. The delivery of the mist is controlled by the provided valve, which can be manipulated by the individual in order to turn on or turn off the delivery of the mist. The prior art cited by the Patent Office does not disclose a similar device. Neither Cushing nor Rosenberg disclose a device that can deliver a continuous stream of fluid, let alone as mist, towards an individual. Rather, Cushing is used to deliver a stream of water for drinking upon the depression of a valve. Rosenberg fails to disclose any device for the delivery of fluids and does not add to Cushing. Also, the device of claim 18 is used to deliver a constant stream of fluid in mist form to an individual without the need for constant manipulation. Once the valve is turned to an open position, a steady stream is expelled through the nozzle. To further point out the distinction, on col. 5, ln. 47-51 of Cushing, the device is described as having a nozzle adapted to "dispense a controlled amount of liquid with each depression of the hand operated valve 46, so that excessive amounts of water are not spilled onto the road." Unlike the adapted nozzle of Cushing, the nozzle of the present invention dispenses a continuous stream of liquid without any depression or activation of a valve, except for initially turning the valve to an open position. Also, the present invention operates by

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spraying fluid as a mist, or "spilling fluid," onto an individual, and likely onto the ground or road also, but it does not direct the delivery of fluid in a localized manner useful for drinking, which is the goal of Cushing. Accordingly, this claim is not anticipated or rendered obvious by Cushing or Cushing in view of Rosenberg.

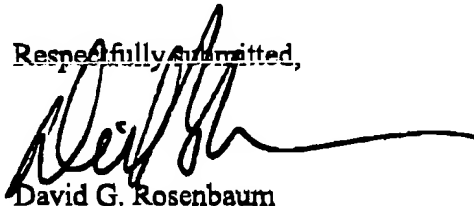
In addition, claims 19 -21 are also novel and unobvious over Cushing, or Cushing in view of the other references cited by the Patent Office, because they are dependent upon claim 18 and, therefore, include all the limitations in claim 18. Additionally, claim 19 provides the additional elements of fluid conduits and a clip for securing the conduit and thus the nozzle for fluid delivery. This provides a novel hands-free feature to the misting apparatus. Also, claim 20 adds the additional element of a belt-like fastener for carrying the misting apparatus, which adds further hands-free ability while using the misting apparatus. In the case of claim 21, the additional element provides for an aperture size that is small enough to emit fluid particles of a size necessary to form an evaporative mist. The particle size characteristics necessary to form an evaporative mist are well-known in the art; therefore, this element is not considered new matter. Therefore, in addition to the novelty basis discussed in the above paragraph, the dependent claims 19-21 are further novel over the prior art because the prior art fails to disclose or teach an evaporative cooling apparatus having an aperture size necessary to form an evaporative mist and allows for portability and operability without continuous manipulation, or essentially hands-free. Accordingly, claims 19-21 are novel and unobvious over the prior art.

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Conclusion

In light of the foregoing amendments and remarks, the applicant respectfully submits that all pending claims (5, 7-12 and 15-21) are in condition for allowance and solicit an early indication to that effect. The examiner is invited to contact the undersigned at the telephone number indicated below in order to discuss any remaining concerns and to expedite allowance of the application.

Respectfully submitted,



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